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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,739	03/10/2004	George D. Hermann	FGRTNA00602	6427
40518 7590 12/23/2010 LEVINE BAGADE HAN LLP 2400 GENG ROAD, SUITE 120 PALO ALTO, CA 94303				
EXAMINER				
RYCKMAN, MELISSA K				
ART UNIT		PAPER NUMBER		
3773				
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12/23/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,739

Applicant(s)

HERMANN ET AL.

Examiner

MELISSA RYCKMAN

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/14/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7.8.11.28-33 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7.8.11.28-33 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the appeal filed on 6/14/10, PROSECUTION IS HEREBY REOPENED in the rejection as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The applicant elected Fig. 19 on 3/19/07, Fig. 19 does not show the first jaw including a lumen extending longitudinally

(claims 8 and 42) therefore, these features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for Fig. 19. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant elected Fig. 19 on 3/19/07, this description does not teach a lumen through a portion of the jaw member.

Claims 32, 33, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The written description does not have support for the distal and proximal portions being detachable from the proximal portion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 11, 28-31, 41 and 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanderson (U.S. Patent No. 243,629).

Sanderson teaches a tissue approximating device comprising:

- first and second jaw ("a") members having terminal ends moveable toward one another, the moveability of the terminal ends defining a plane of coaptation (Fig. 1)
- a tissue engaging rod (a), said tissue engaging rod having a tissue engaging portion that can extend generally out of the plane of coaptation in a first position (putting pressure on "c" moves "a" out of the plane of coaptation), said tissue engaging rod moveable to a second tissue engaging position that transects the plane of coaptation (Fig. 2) and thereby positioning tissue contacted by the tissue engaging rod between the first jaw member and the tissue engaging rod, and between and second jaw member and the tissue engaging rod (capable of being used as described)
- wherein the tissue engaging rod is configured to extend independently of the first and second jaw member (putting pressure on c moves the rod independently).
- said tissue engaging rod is pivotally attached to said first and second jaw members (a is attached to a" via c in Fig. 2)
- positioning tissue contacted by a tissue engaging rod between the first and second jaw end members (capable of being used as described)

- positioning tissue comprises moving a tissue engaging rod having a tissue engaging portion that can extend generally out of the plane of coaptation into a first position (capable of being used as described)
- moving a tissue engaging rod (a) comprising moving the tissue engaging rod to a second tissue engaging position that transects the plane of coaptation (Fig. 1)
- a first handle (portion of "a" proximal of element as shown in Fig. 3 is the handle) integral with the first jaw member, and further comprising a second handle integral with the second jaw member (Fig. 1)
- the first jaw and the second jaw members are rotatably attached to the hinge (the hinge is the curved portion at the distal end of the device, jaws "a" move with respect to "c" and "a")
- the first and second jaw members have inner surfaces facing toward one another (Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 33, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanderson (U.S. Patent No. 243,629) as applied to claims 7 and 41 above.

Sanderson teaches the claimed invention including the distal portion forms a substantially non-zero angle with respect to the proximal portion (Fig. 2, curves in e form angle with a") but does not specify the first jaw member comprises a distal portion and a proximal portion with the distal portion being detachable from the proximal portion. However it would have been obvious to one of ordinary skill in the art to make the proximal and distal portions separable, as this is well known and would perform equally as well as the proximal and distal pieces being integral (Nerwin v. Erlichman 168 USPZ 177 (1969)).

Claims 8 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanderson (U.S. Patent No. 243,629) as applied to claims 7 and 41 above, and further in view of Castro et al. (U.S. Patent No. 5,520,704).

Sanderson teaches the claimed invention but is silent regarding said first jaw member includes a lumen extending longitudinally through at least a portion of the first jaw member, however Castro teaches a lumen extending partially through at least a portion of the first jaw member (distal end of 12, Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sanderson with Castro as having a lumen in the jaw increases the functionality of the forceps by

Art Unit: 3773

being able to add different pieces to the forceps, such as needles or pads depending on the application.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on a flexible schedule, email address is melissa.ryckman@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR
/Melissa Ryckman/
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773